

REMARKS

This Amendment is being submitted in response to the Official Action dated December 9, 2009. Claims 1, 4, 10, 11 and 13 are amended. Claims 5 and 12 having been previously cancelled and claim 8 having been previously withdrawn, claims 1-4, 6, 7, 9-11, 13 and 14 remain pending in this application.

The drawings were objected to under 37 CFR 1.83(a) because the limitations: "the thin rigid sheet of material having an annular lip protruding rearwardly there from for insertion into, seating within and proper positioning with said cutout" and "a convex inner edge" recited in claim 1 and "the accent frame flares slightly away from the planar surface" recited in claim 4 are all ostensibly not shown in the drawings. Applicant disagrees. With regard to the limitation "the thin rigid sheet of material having an annular lip protruding rearwardly there from for insertion into, seating within and proper positioning with said cutout", Applicant notes that [para 0030] discloses that "the accent frame 5 is comprised of a thin sheet of rigid material...A lip 10 may extend rearward from the aperture 6 into the cut out 20 to serve as a guide for proper positioning." Both Figs. 1 and 2 depict the accent frame 5 comprised of a thin sheet of rigid material...with lip 10 extending rearwardly to serve as a guide for proper positioning. This objection to the drawings under 37 CFR 1.83(a) is respectfully traversed. With regard to "a convex inner edge", Applicant has amended "convex" to "circular" which is described at [para 0030] and the circular inner edge 6 is clearly depicted in FIGs. 1-2. With regard to "the accent frame flares slightly away from the planar surface" as recited in claim 4, this is amply described at [para 0019] as purely aesthetic variation that provides an aesthetically pleasing depth or texture to the frame. Such structural detail is not essential for a proper

understanding of the disclosed invention under MPEP § 608.02(d).

The Examiner rejected claims 1 and 8 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement and rejected claims 1-4, 8-11 and 14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant notes that claim 8 was withdrawn in its Amendment filed 31 July 2006. Consequently, it believes that the Examiner's rejections directed to that claim were made in error and requests that they be withdrawn.

Regarding claim 1, the Examiner states that even though Applicant's specification states "the accent frame (5) may be formed with a slight convex curvature", it insufficiently discloses that the inner edge is convex. Applicant herein amends the term convex to —circular—which is unmistakably shown and described.

Regarding claim 1, Examiner contends that the claim 1 reference to the shape of the frame (5) is indefinite, namely "said rigid thin sheet having an outer edge defining a flat two-dimensional object-shape" in lines 8-9 and "the flat two-dimensional object shaped outer edge" in line 15 are incorrectly stated because an edge would have three dimensions. [para 0032] states "The material of the accent frame 5 may be designed to sit flush against the wall, ceiling, or floor structure 30 and sufficiently thin *so that no perceptible dimension of thickness is apparent to an observer.*" [para 0031] states "The accent frame 5 is further provided with an outer edge 7 defining a patterned perimeter. It is intended that the patterned perimeter be formed in a geometric shape or in a shape that suggests an object, for example a star (FIG. 1), a flower (FIG. 2), or a house (FIG. 3)." Given no perceptible thickness Applicant maintains that the outer edge

indeed circumscribes and *defines a flat two-dimensional object-shape* exactly as claimed, despite some apparent thickness to the edge if viewed under a magnifying glass. The proper inquiry is whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art, and the imperceptibly thin “outer edge defining flat two-dimensional object-shape” (such as a star) fulfills the requisite burden of clarity and precision, certainly better than the imperceptibly thin outer edge defining an imperceptibly thin three-dimensional object-shape. If the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the Examiner merely wants the applicant to improve the clarity or precision of the language used, the claim should not be rejected under 35 U.S.C. 112, second paragraph, rather, the Examiner should suggest improved language to the Applicant.

The Examiner rejected claims 1-3, 6, 9, 10, 13, and 14 as obvious under 35 U.S.C. 103(a) over Bobrick (US 3,697,742) in view of Hill (US 4,800,239). The Examiner contends that Bobrick shows a recessed lighting fixture mounted on one side of a planar surface, the surface having a cutout above which the lighting fixture is mounted and a finishing ring (46) mounted on the other side of the planar surface, having an aperture conforming to the cutout and attached to the lighting fixture so as to provide a transition from the planar surface to the fixture. The Examiner acknowledges, however, that Bobrick does not disclose elements of the present invention including an accent frame comprising a rigid thin sheet of material having an outer edge defining a shape in two dimensions, an inner edge defining an aperture conforming to the cutout of the planar surface, and an annular lip circumscribing the inner edge and extending upward so as to position the accent frame in the cutout of the planar surface. The Examiner further acknowledges that Bobrick is silent as to maintaining such an accent ring in place by

pressure of the light fixture finishing ring nor the aesthetic impact of the accent frame as a fixture backdrop and concealer for planar surface imperfections. The Examiner asserts that Hill discloses the absent elements of the present invention in the context of a wall plate, including an annular lip, but a lip that does not protrude rearwardly as claimed. Applicant disagrees. The Examiner cites Hill (l) (alphabetical references refer to Examiner's annotated Fig 1 excerpted from Hill) for the annular lip, but Hill does not disclose an annular lip at all in Fig.1. Rather, Hill discloses a thin sheet of material with decorative scalloped corners (c) and an inner (i) and outer (e) edges. There is no lip present. The Examiner relies on Bobrick to teach that an annular lip is advantageous for allowing easier insertion of the element (46) into the cutout (Fig 2, 5). This is not the case. Bobrick teaches "an elongated cylindrical sleeve 48", not a "lip" which is defined as 4 a : the edge of a hollow vessel or cavity b : a projecting edge [Merriam-Webster], and not at all as a means to allow easier insertion into a cutout, but rather as a bulb housing that provides purchase from the flanges (50, 52) for attachment of extension members to allow connection to the hooks (58). Therefore, Bobrick does not teach that an annular lip is advantageous for allowing easier insertion of the element (46) into the cutout (Fig 2, 5), nor does Hill, and the Examiner's rejection is traversed. The Examiner's conclusion as to the obviousness of creating a convex inner edge to define a circular aperture is now moot as Applicant herein amends the term "convex" to "circular".

Regarding Claim 13, the Examiner states that Hill teaches that the accent frame (10) "is both decorative and is capable of covering up any imperfections in the edges of the cutout not covered by the finish ring". However, this is not the case. Hill envisions the accent frame (10) as decorative and capable of covering cosmetic irregularities of material attached to the

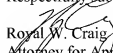
faceplate(s) (1-4), not structural irregularities that may exist around the cutout. Hill states “the trim frame...conceals any irregular or ragged perimeter of the wallpaper, fabric, or other material attached to the decorator plate”.

Regarding Claim 14, the Examiner concedes that Bobrick modified by Hill does not disclose the object-shape as a closed form consisting of a star, flower, or house. But, the Examiner goes on to conclusively state that it would be obvious to modify Bobrick and Hill to a different shape. Applicant respectfully disagrees with the Examiner’s assertion. First, Bobrick modified by Hill does not disclose a closed form consisting of a star, flower or house; in fact, it doesn’t disclose any closed forms. Rather, Hill merely has a slightly scalloped edge on its frame. Further, it’s not clear if this edge in Hill is based on aesthetic concerns, economic concerns, manufacturing concerns, or otherwise; i.e., possibly it is easier or cheaper to produce an outside frame with a scalloped edge than it is a strictly circular outside shape).

With regard to Claim 4, the Examiner states that Baldwin teaches an accent frame (11) that flares away from the planar surrounding planar surface. This is misinterpretation of Baldwin’s drawings. Baldwin Figs. 1 and 3 show an accent frame, but the figures simply do not show the frame (11) flaring away from the planar surface (23) as Applicant’s does. All portions of Baldwin’s accent frame (11) remain in contact with the planar surface (23).

In view of the above, pending claims 1-4, 6, 7, 9-11, 13 and 14 are believed to avoid all of the rejections set forth in the Official Action. It is believed that this application is now in the proper condition, and a Notice of Allowance is respectfully requested.

Respectfully submitted,


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